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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
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KLINKEL, KORTNEY L

ART UNIT	PAPER NUMBER
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4131

NOTIFICATION DATE	DELIVERY MODE
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02/11/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/579,396	<b>Applicant(s)</b> TORMO I BLASCO ET AL.	
	<b>Examiner</b> KORTNEY KLINKEL	<b>Art Unit</b> 4131	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 7-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/15/2006</u> .                                               | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claims***

Receipt is acknowledged of a preliminary amendment filed on May 15, 2006 in which claims 4 & 7-10 were amended. Claims 1-11 are pending in the instant Office action.

### ***Information Disclosure Statement***

Acknowledgement is made of applicant's submitting of the information disclosure statement (IDS) on May 15, 2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement (IDS) has been considered by the examiner.

### ***Claim Objections***

Claim 7 is objected to because of the following informalities: claim 7 currently recites "...claims 5 or 6", it should recite "...claim 5 or 6". Appropriate correction is required.

Claims 8-9 objected to under 37 CFR 1.75(c), as being of improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

### ***Title***

The title of the invention is not descriptive. It is unclear what is meant by the term, "Fungal". There is no support for the term fungal, Examiner assumes that Applicants intended to use the term fungicidal. The following title is suggested: Fungicidal Mixtures for Controlling Rice Pathogens.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite in that there is no clear and positive prior antecedent basis for the term “them II” in the claim. It would be remedial to amend the claim to provide a clear antecedent basis for the term “them II”.

Dependent claims 5, 6, and 11 recite the limitation “the compound I” and “the compound II”. There is insufficient antecedent basis for this limitation in the claim since the parent claim on which they all depend recites “the formula I” and no reference to either formula II or compound II.

Dependent claim 2 recites the limitation “the compound II” and dependent claim 3 recites the limitation “the formula II”. There is insufficient antecedent basis for this limitation in the claim since the parent claim on which they depend recites “the formula I” and no reference to either formula II or compound II.

Dependent claims 6 and 7 recite the limitation “applied simultaneously, that is jointly or separately, or in succession”. Claim 6 is internally inconsistent because its parent claim, claim 1, indicates that compounds of formula I and II are in admixture. A mixture does not allow for separate or successive application of ingredients contained therein. There is insufficient antecedent basis for this limitation in the claims.

Claim 11 provides for the use of the compound I and the compound II, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it

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merely recites a use without any active, positive steps delimiting how this use is actually practiced.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 11 provides for the use of the compound I and the compound II...for preparing a composition suitable for controlling harmful fungi, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 11 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Please note, that for the purposes of examination, the Examiner is making the assumption that a compound of formula II, or compound II was intended to be recited in claim 1, with respect to the phosphorous acid  $\text{H}_3\text{PO}_4$ , its alkali metal or alkaline earth metal salts or derivatives, rather than the term "them II".

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pees et al. (WO 98/46607) in further view of Williams et al. (Proceedings 1977 British Crop Protection Conference – Pests and Diseases, LS 74-783, a new systemic fungicide with activity against phycomycete diseases).

Applicants claim a fungicidal mixture which comprises the triazolopyrimidine derivative of formula I and phosphorous acid  $\text{H}_3\text{PO}_4$ , its alkali metal or alkaline earth metal salts or derivatives in a synergistically effective amount.

Pees et al. teach triazolopyrimidine derivatives of formula I (See page 3, lines 5-15 and Example 2 on page 20 for preferred compound of instant claim 1) to have enhanced systemic activity and enhanced fungicitoxy against rice diseases (page 7,

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lines 8-11), namely for the control of phytopathogenic fungi such as *Alternaria solani*, *Botrytis cinerea*, *Cercospora beticola*, *Cladosporium herbarum*, *Corticium rolfsii*, *Erysiphe graminis*, *Helminthosporium tritici repentis*, *Leptosphaeria nodorum*, *Micronectriella nivalis*, *Monilinia fructigena*, *Mycosphaerella ligulicola*, *Mycosphaerella pinodes*, *Pyricularia grisea* f. sp. *oryzae*, *Rhizoctonia solani* and *Sclerotinia sclerotiorum*, *Uncinula necator*, in particular for the control of *Uncinula necator* (page 7 lines 13-19). Note particularly page 17, line 7 to page 19, line 2; especially page 17, line 19-22 states, "These mixtures of fungicides can have a broader spectrum of activity than the compound of general formula I alone. Furthermore, the other fungicide can have a synergistic effect on the fungicidal activities of the compound of general formula I." Pees discloses that fosetyl aluminum (page 18, lines 3-4) as one of the possible other fungicides that can show a synergistic effect with the triazolopyrimidine derivative of question.

Pees also teaches the use of the triazolopyrimidines as a fungicidal composition comprising the triazolopyrimidine derivative in the instant application and also said triazolopyrimidine in combination with a second active ingredient (page 12, lines 3-6 and 9-10 respectively) further comprising a liquid or solid carrier (page 12, lines 19-21). Pees also discloses the method of using the above mentioned fungicidal mixture to treat the fungi, soil, peat, plants, seeds etc. (page 19, lines 3-12).

The instant invention differs from Pees in that the cited reference does not *distinctly* disclose the combination of the triazolopyrimidine with fosetyl aluminum. This deficiency is addressed through the teachings of Williams et al.

Williams et al. teach the fungicidal properties of fosetyl aluminum, also known as aluminum tris(ethyl phosphonate), which is disclosed as LS 74-783 throughout the document (page 565, Summary) and more specifically the synergistic effects of LS 74-783 with other proven fungicides (page 571, section (iii) including Table 8). Table 8 discloses the dose combination (weight ratio) of LS 74-783 with a second fungicide. Both disclosed weight ratios fall within the ranges disclosed by Applicant. In the case where the claimed ranges overlap or lie inside ranges disclosed by the prior art, a *prima facie* case of obviousness exists, see MPEP 2144.05. It would be within the capability

of one of ordinary skill in the art to determine the necessary concentrations of a particular fungicide or fungicidal mixture necessary to exhibit maximum fungicidal effects in controlling harmful fungi.

It would have been *prima facie* obvious to one of ordinary skill in the art at the time of the instant invention to combine the teachings of the two references to develop the fungicidal mixtures claimed in the instant application. Pees teach that triazolopyrimidines are functional as fungicides and also show synergy when used in combination with other known fungicides. Likewise, Williams teach that fosetyl aluminum is a known fungicide and it is also known to show a synergistic effect in combination with other known fungicides. "It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Applicant's data in the specification has been considered. Because both Pees and Williams show synergistic effects with triazolopyrimidines and fosetyl aluminum respectively in combination with a large number of other known fungicides, there is a high expectation of synergy in the instant claimed combination. It could be reasonably argued that in most cases, additive or better than additive results should be expected for the combination of such fungicides to one of ordinary skill in the art. For the reason outlined above, claims 1-11 are deemed *prima facie* obvious in light of the teachings of the prior art and rejection under 35 U.S.C. § 103 is appropriate.

### **Conclusion**

Claims 1-11 are rejected. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kortney Klinkel, Ph.D. whose telephone number is (571)270-5239. The examiner can normally be reached on Monday-Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres (571)272-0867 or Cecilia Tsang (571)272-0562 can be



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reached at the respective numbers. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KLK

/Cecilia Tsang/  
Supervisory Patent Examiner, Art Unit 4131